REMARKS

Claims 1 - 16 are currently pending in this patent application, claims 1, 6, 10 and 12 - 16

being independent claims.

Claims 1, 2 and 6 have been amended in order to more particularly point out, and distinctly

claim the subject matter to which the applicants regard as their invention. It is believed that this

Amendment is fully responsive to the Office Action dated July 27, 2007.

Claims 1 - 9 have been objected to due to certain informalities set forth in item 1, page 2 of

the outstanding Office Action. The applicants respectfully request reconsideration of these

objections.

As indicated above, claims 1, 2 and 6 have been amended in order to more particularly point

out, and distinctly claim the subject matter to which the applicants regard as their invention, and in

order to correct certain informalities therein, including those pointed out by the Examiner.

Accordingly, the withdrawal of the outstanding objections to the claims is in order, and is

therefore respectfully solicited.

-9-

Claims 13 and 14 stand rejected under 35 USC § 101 for the reasons specifically set forth

in the second full paragraph in item 2, page 2 of the outstanding Office Action. The applicants

respectfully request reconsideration of this rejection.

The applicants submit that in July 1998, the Court of Appeals for the Federal Circuit, in the

case of State Street Bank and Trust Co. v. Signature Financial Group, Inc., 47 USPQ2d 1596 (Fed.

Cir. 1998), suggested that almost any unobvious software-related invention is patentable if the

claims are properly drawn. The patent involved in the State Street Bank case, U.S. Patent No.

5,193,056, is generally directed to a data processing system for implementing an investment

structure dealing with the administration and accounting of mutual stock funds.

The court held that the transformation of data in a software-related patent (e.g., in the State

Street Bank case, which represented "discrete dollar amounts, by a machine through a series of

mathematical calculations into a final share price") constitutes:

(a) a "practical application of a mathematical algorithm, formula, or calculation," but

(b) nevertheless, produces "a useful, concrete and tangible result."

In the instant case, it is clear that the claimed invention, set forth in each of claims 13 and

14, meets not only item (1), above, but also item (2) in any of the claimed steps recited in the claims.

-10-

In view of the above, the withdrawal of the outstanding rejection under 35 USC § 101 is in order, and is therefore respectfully solicited.

As to the merits of this case, the following rejections are set forth in the outstanding Action:

- (1) claims 1 4, 6 8, 10 and 12 16 stand rejected under 35 USC § 103(a) based on Ohnuki (U.S. Patent No. 4,969, 003) in view of Hamamura (U.S. Patent No 5, 815, 748);
- (2) claims 5 and 9 stand rejected under 35 USC § 103(a) based on Ohnuki (U.S. Patent No. 4,969,003) in view of Hamamura (U.S. Patent No 5, 815, 748) and further in view of Terasaki (U.S. Patent No. 7,119, 843); and
- (3) claim 11 stands rejected under 35 USC § 103(a) based on Ohnuki (U.S. Patent No. 4,969, 003) in view of Hamamura (U.S. Patent No 5, 815, 748) and further in view of Iida (U.S. Patent No. 5,001, 507).

The applicants respectfully request reconsideration of these rejections.

The applicants have amended the claims so as to highlight: "a focusing mechanism for

moving said optical system to an auto-focusing position or a fixed focus position" in each of claims

1 and 6. The amendments are to clarify a focusing mechanism, support of which can be found in

paragraphs [0082] and [0137] in the applicants' specification, and illustrated in, for example, the

applicants' Figures 1, 14 and 15.

As to the claimed "controller," now recited in claims 1, 2 and 6, the amendment is made so

as to clarify a controller, support of which can be found in the applicants' specification in paragraph

[0006].

More particularly, the claimed "controller," as now recited in, e.g., claim 1, operates such

that:

1. in the case where a shutter operation of the switch is performed during a focusing action

of the focusing mechanism due to the switch;

2. the optical system is shifted to a fixed focus position from an auto-focusing position; and

3. a fixed focus image is taken.

It is submitted that Ohnuki does not teach all of the above-mentioned features of the claimed

invention.

-12-

With respect to the Ohnuki reference itself, the part cited for "a control part," such element

in Ohnuki is merely described as follows: "in a case where the switch SW2 turns on at a time during

the above-described cycle of focus adjustment, and the release interruption occurs, the release

operation immediately follows. At the time point of the completion of the exposure preparation, the

lens is stopped and the exposure operation is carried out." See, lines 54 - 59, column 18 in Ohnuki.

As to the above-discussed claimed "controller," the optical system is shifted to a fixed focus

position from an auto-focusing position, and a fixed focus image is taken. As described in the

applicants' specification, the object of the applicants' invention is to provide "an electronic device

which is able to photograph by means of an AF (auto-focusing) function and a PF (pan-focus: a

fixed focus) function, to make it possible to select automatically a taken image from a relation

between an AF function and a shutter operation, and to give improvement of quickness of taking of

an image." Such structural arrangement is not disclosed or suggested in Ohnuki. The object of

quick taking of an image is realized by the above stated claimed structural arrangement.

Such quick taking of an image enables photography in response to various objects, and

enables provision of an electric device for improving satisfaction of a user.

The applicants submit that the above-discussed claimed structural arrangements, and the

advantages or benefits derived therefrom are not disclosed in the cited prior art references, including

-13-

the primary reference, Ohnuki, and the secondary references, Hamamura, Terasaki, and Iida. Thus,

the suggested combined teachings of these references would still fall far short in fully meeting the

applicants' claimed invention, as now recited in the amended claims filed herewith. Accordingly,

a person of ordinary skill in the art would not have found the applicants' claimed invention, as now

recited in the amended claims, obvious under 35 USC § 103(a) based on the teachings of the cited

prior art references, singly or in combination.

In view of the above, the withdrawal of the outstanding obviousness rejections under 35 USC

§ 103(a) is in order, and is therefore respectfully solicited.

In view of the aforementioned amendments and accompanying remarks, claims, as amended,

are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the

Examiner is requested to contact the applicants' undersigned attorney at the telephone number

indicated below to arrange for an interview to expedite the disposition of this case.

-14-

U.S. Patent Application Serial No. 10/826,501 Response filed November 27, 2007 Reply to OA dated July 27, 2007

In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper to Deposit Account No. 01-2340.

Respectfully submitted,

KRATZ, QUINTOS & HANSON, LLP

Mel R. Quintos Attorney for Applicants Reg. No. 31,898

MRQ/lrj/ipc

Atty. Docket No. **040075** Suite 400 1420 K Street, N.W. Washington, D.C. 20005 (202) 659-2930 23850

PATENT & TRADEMARK OFFICE

Enclosures: Petition for Extension of Time (one month).

H:\HOME\MEL\TRANSFER\040075 AMENDMENTw-Ext1f.11-27-07